

## REMARKS

The Official Action mailed January 23, 2008, has been received and reviewed. The TITLE is objected to and is amended herein. Claims 1 through 22 are pending in the application. Claims 1 through 3 stand rejected and claims 4 through 22 are objected to. Claims 1 through 22 are amended herein. Applicant respectfully requests consideration of claims 1 through 22 as amended and the allowance of the pending claims.

### In the TITLE

Applicant has amended the TITLE herein to better describe the subject matter which is claimed in amended claims 1 through 22. Amendment of the TITLE is respectfully requested.

### 35 U.S.C. § 102(b) Anticipation Rejection

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Daniel Crosnier, U.S. Patent 5,267,673. Applicant respectfully traverses this rejection.

Claim 1 is amended herein to include recitations of originally filed claim 2, which was not rejected under 35 U.S.C. § 102(b). In particular, amended claim 1 now recites, in part, a co-acting part having a “predetermined diameter variation” which is not described in Crosnier. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Crosnier’s failure to describe a co-acting part having a “predetermined diameter variation” as recited in amended claim 1 precludes an anticipation rejection of claim 1 under 35 U.S.C. § 102(b).

While claim 1 was not rejected under 35 U.S.C. § 103(a), Applicant notes that the amendment of claim 1 to include recitations originally found in claim 2 does not raise a *prima facie* obviousness rejection of claim 1 because Crosnier fails to teach or suggest at least a co-acting part having a “predetermined diameter variation” as recited in amended claim 1. An obviousness rejection can only be supported if there is “a finding that the prior art included each element claimed...with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.” *See*, M.P.E.P. § 2143 A. Here, Crosnier fails to describe a co-acting part having a “predetermined diameter

variation” as recited in amended claim 1. The lack of such description precludes an obviousness rejection of amended claim 1.

For at least the foregoing reasons, Applicant respectfully requests the withdrawal of the 35 U.S.C. § 102(b) rejection of amended claim 1.

### **35 U.S.C. § 103(a) Obviousness Rejections**

Claims 2 and 3 stand rejected under 35 U.S.C. § 103(a) as being obvious in light of Crosnier combined with James Boyd (Pub. Strength of Materials). Applicant respectfully traverses these rejections.

Claim 2 is amended herein and depends from claim 1. As a dependent claim of non-obvious independent claim 1, claim 2 is also non-obvious. *See, M.P.E.P. §2143.03 (citing, In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988))* (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.”)).

Further, claim 2 is non-obvious because neither Crosnier or Boyd describe a co-acting part having a “predetermined diameter variation” as recited in claim 1, from which claim 2 depends.

Claim 3 also depends from independent claim 1 and is not obvious because claim 3 depends from a non-obvious independent claim. *See, In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).*

Claims 4 through 22 are amended herein. Each of claims 4 through 22 depend, either directly or indirectly, from non-obvious independent claim 1. As dependent claims of non-obvious independent claim 1, claims 4 through 22 are also non-obvious. *See, In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).*

For at least the foregoing reasons, claims 2 through 22 are not obvious and should be allowed over the rejections under 35 U.S.C. § 103(a).

### **ENTRY OF AMENDMENTS**

The amendments to the TITLE and to claims 1 through 22 herein should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

### **CHANGE OF CORRESPONDENCE ADDRESS AND POWER OF ATTORNEY**

Applicant is filing herewith a Power of Attorney and Correspondence Address Indication Form (PTO/SB/81) and the necessary Statement under 37 C.F.R. § 3.73(b). Please change the Applicant's correspondence address to correspond with Customer Number 66061.

### **CONCLUSION**

Claims 1 through 22 are believed to be in condition for allowance, and an early notice thereof is respectfully submitted. Should the Examiner determine that additional issues exist which might be resolved by a telephone conference, they are respectfully invited to contact the Applicant's undersigned representative.

The Director is hereby authorized to charge any additional fees or underpayments of fees under 37 C.F.R. §§ 1.16 and 1.17, or to credit any overpayments, to Deposit Account Number 50-4071. Applicant is a large entity.

Respectfully Submitted,



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